

**REMARKS**

A Petition for Extension of Time (for two months) is being concurrently filed with this Amendment. Thus, this Amendment is being timely filed.

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendments to the claims and the following remarks.

***Status of the Claims***

In the present Reply, claims 21-39 have been amended. Also, claims 1-20 and 40-41 stand withdrawn from consideration. Thus, claims 1-41 are pending in the present application.

No new matter has been added by way of these amendments because each amendment is supported by the present specification. For example, the amendment to claim 21 has support in claim 31 and in the specification at page 19, lines 7-11. The amendments to claims 22 and 23 are also supported at, e.g., page 19, lines 7-11. The changes to the remaining claims are editorial in nature. By deleting/amending these terms in order to clarify the claimed invention (e.g., "A gene cassette" to "The gene cassette"), Applicants in no way are conceding any limitations with respect to the interpretation of the claims under the Doctrine of Equivalents.

Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner  
~~withdraw all rejections and allow the currently pending claims.~~

---

***Information Disclosure Statement***

At pages 3-4 of the Office Action, the Examiner indicates that some references from previously submitted Information Disclosure Statements (IDSs) are not being considered for several reasons. Applicants will file the Supplemental IDS in the near future, wherein all of the cited references that were previously cited but not considered by the Examiner will be attached thereto.

***English Language Translation of Priority Document***

Applicants herein enclose verified English language translations of both priority documents for this application (Japanese Applic. No. 2002-268726, filed September 13, 2002; Japanese Applic. No. 2002-060374, filed March 6, 2002). Applicants respectfully request acknowledgement that both documents have been received, as well as an indication that the present application is entitled to priority with respect to least the filing dates of these Japanese language documents.

***Claim Objections***

Claims 29-39 stand objected to under 37 C.F.R. § 1.75(c) for improper multiple dependencies. Applicants respectfully refer the Examiner to the disputed claims as presented herein. It is believed that each claim properly depends on the previous claim(s).

---

The Examiner also indicates that the claims contain grammatical or typographical errors.

It is believed that such minor errors have been corrected herein.

Finally, Applicants respectfully note the changes to claims 24 and 25 herein.

Reconsideration and withdrawal of this objection are respectfully requested.

***Issues under 35 U.S.C. § 112, First Paragraph***

Claims 21-28 stand rejected under 35 U.S.C. § 112, first paragraph, for asserted lack of written description (see pages 5-7 of the Office Action). Applicants respectfully traverse, and reconsideration and withdrawal of this rejection are respectfully requested.

First, Applicants note the last paragraph shown on page 6 of the Office Action. Second, Applicants respectfully refer the Examiner to the claims as presented herein since they are directed to the *Bombyx mori*. It is believed that this rejection has been overcome. Reconsideration and withdrawal of this rejection are respectfully requested.

***Issues under 35 U.S.C. § 112, Second Paragraph***

Claims 22-28 stand rejected under 35 U.S.C. § 112, second paragraph, for the reasons stated on pages 7-9 of the Office Action. Applicants respectfully traverse and reconsideration is based on the following remarks.

Applicants respectfully refer the Examiner to the claims as presented herein. Also, Applicants note the definition of a “gene cassette” at page 15, lines 12+ of the present specification. Thus, it is believed that this rejection has been overcome. Reconsideration and withdrawal of this rejection are respectfully requested.

---

***Issues under 35 U.S.C. § 102(b) and § 103(a)***

Claims 21-25 and 27 stand rejected under 35 U.S.C. § 102(b) as being anticipated by

Zhao *et al.* (*Acta Biochimica et Biophysica Sinica*, Vol. 33(1), pp. 112-116 (2001)) as evidenced by Zhang *et al.* (*Acta Biochimica et Biophysica Sinica*, Vol. 31(2), pp. 119-123 (1999)) and GenBank Acc. No. AF226688 (see pages 9-10 of the Office Action).

Also, claims 26 and 28 stand rejected under 35 U.S.C. § 102(b) as being anticipated by, as applied to claims 21-25 and 28 above; or, in the alternative, under 35 U.S.C. § 103(a) as being unpatentable over Zhao *et al.* *ysica Sinica*, Vol. 33(1), pp. 112-116 (2001)) as evidenced by Zhang *et al.* and GenBank Acc. No. AF226688, as applied to claims 21-25 and 28 above, and further in view of Zhou *et al.* (*Nucleic Acids Res.*, Vol. 28(12), pp. 2413-2419 (2000)) (see pages 11-13 of the Office Action).

Applicants respectfully traverse, and reconsideration and withdrawal of all rejections are respectfully requested.

Applicants respectfully refer the Examiner to the disputed claims as presented herein. The cited reference(s), or combination(s) thereof, fails to disclose all claimed features. For instance, claim 31 is not at issue here, wherein this subject matter now appears in independent claims 21-23.

Thus, because “a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference,” the cited Zhao *et al.* reference cannot be a basis for a rejection under § 102(b). See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Thus, because of the lack of disclosure of all features as instantly claimed, the § 102(b) rejections in view of Zhao *et al.* are overcome.

Furthermore, a *prima facie* case of obviousness requires disclosure of all claimed features. *See In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991). That is not the case here as mentioned above. Thus, the § 103(a) rejection has also been overcome.

Based on the above, reconsideration and withdrawal of all rejections are respectfully requested.

### ***Conclusion***

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone number of the undersigned below.

Application No. 10/506,327

Docket No.: 0210-0190PUS1

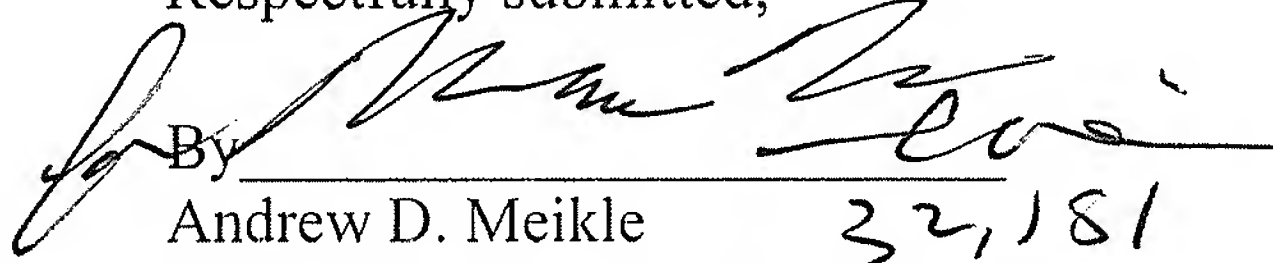
Art Unit 1633

Reply to Office Action of October 30, 2006

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: March 30, 2007

Respectfully submitted,

By  32,181

Andrew D. Meikle

Registration No.: 32,868

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road

Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicant

Attachments: Verified English language translation of Japanese Applic. No. 2002-268726  
Verified English language translation of Japanese Applic. No. 2002-060374